

Remarks

The present Response is to the Office Action mailed 04/28/2010 made final. Claims 13 and 15-23 are presented for examination.

Response to Arguments

2. Applicant's 1/25/2010 arguments with respect to the 35 USC 102 rejection set forth in section 6 of said previous Office action have been fully considered and are persuasive. Accordingly said rejection is withdrawn.
3. Applicant's 1/25/2010 arguments with respect to the 35 USC 103 rejection set forth in section 7 of said previous Office action have been fully considered but they are not persuasive.

Applicant argues on page 7:

"Therefore, applicant amends the claim to clarify that a first Internet site is accessible by the computerized appliance comprising bill-payment software providing an interactive interface enabling the user to select, view and pay itemized bills gathered from billing sources at third Internet sites. Applicant argues that the art of Schrader allows a user to navigate to one Internet site at Wells Fargo and view and pay a credit card bill. The credit card bill may teach itemized transactions, but these transactions are not itemized bills gathered from third Internet sites, as claimed. Schrader merely teaches that a user can log onto their account at a single biller and pay their bill. Applicant's invention improves upon this art by providing bills for payment to a user that were gathered for the user at third enterprise sites. Schrader does not teach or suggest gathering bills from other Internet sites and presenting them to the user and providing a facility to select and pay those bills. Schrader provides one site from one biller wherein a user can pay the bill at the site."

Response:

Resort may be had to MPEP section 2144.04 as well as the following case law as evidence of the level of knowledge of one of ordinary skill in support of the following contentions.

A. *In re Shepard*, 138 USPQ 148 (CCPA 1963)

"In considering disclosure of reference patent, it is pertinent to point out not only specific teachings of patent but also the reasonable inferences which one skilled in the art would logically draw therefrom."

B. *In re Bozek*, 163 USPQ 545 (CCPA 1969)

"Reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred"

C. *In re Fout*, 213 USPQ 532 (CCPA 1982), *In re Siebentritt*, 152 USPQ 618 (CCPA 1967)

"Express suggestion to substitute one equivalent technique for another need not be present to render such substitution obvious"

D. *In re Wood*, 202 USPQ 171 (CCPA 1979)

"In resolving the question of obviousness under 35 USC 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved"

As admitted by applicant, Schrader clearly discloses a user logging onto an account at a biller to pay a bill. Duplicating this process allows for multiple bills to be paid at multiple billers. Aggregating this data into one location is obvious to one of ordinary skill in the art because aggregation and manipulation of data is the primary purpose of computers.

Schrader clearly discloses in, for example, Fig. 16 updating information from online banking accounts. One of ordinary skill in the art would be apprised that this number of accounts could be duplicated for any number of accounts.

As for the argument "Schrader does not teach or suggest gathering bills from other Internet sites and presenting them to the user and providing a facility to select and pay those bills". Schrader appears to provide software (Quicken) that resides locally on a user's computer, however there is no novelty in having the program and data gathering methods reside on a server that a user must log in to access. One of ordinary skill would understand this to be an obvious separation of parts, i.e. moving the software from one computer to another and then accessing it in another fashion, i.e. by PDA, cell phone, etc. Regardless the end result is the same, the process of accessing and presenting itemized bills for payment is disclosed. Fig. 14 shows support for the Examiners contention in that Application interface 1403 can be considered the "second internet site" that collects the itemized bills and bill related data.

"The application interface module 1403 enables the personal online finance application 304 to execute as a plug-in in various online environments such in America Online. TM., Netscape Communications Inc.'s Navigator. TM., and Microsoft Corp.'s Internet Explorer. TM .. This module is implemented on a per environment basis. When invoked, this module initializes the rest of the personal online finance application 304 and on completion ensures its safe termination. The application interface module 1403 is a hidden window that transfers data from the user interface and the rest of the modules using a messaging architecture. This module transfers state information from the operating environment to the user interface module 1401, and to the other modules. This enables the application 304 to be used with a variety of different operating environments.

(52) A platform independent layer 1405 comprise of three modules. All these modules may be recompiled on a different platform and their implementations do not vary significantly on other desktops."

Fig. 3 of Schrader, item 111 is a drop down menu allowing the user to change the account particulars being viewed. This of course would include bills from the credit card companies or ANY OTHER institution capable of sending a bill. Again, the use of the internet and its inherent benefits are clearly obvious to one of ordinary skill in the art. I.e. the use of servers, duplication of parts for reliability, ease of access of data from any point of access, etc. Again, this is general knowledge of one of ordinary skill in the art of computers and bill pay systems.

Fig. 4 also shows online bill payment to a credit card and city garbage. Again, it is considered that one of ordinary skill in the art would know that if the companies did have the ability to remit payments via the internet they would for the cost benefits of eliminating paper, handling, postage, etc.

4. Applicant's 1/25/2010 arguments with respect to the 35 USC 102 rejection set forth in section 8 of said previous Office action have been fully considered but they are not persuasive.

Applicant argues on page:

"Applicant points out that the reference of Remington teaches (Abstract) A bill presentment and payment remittance system is configured for use over an electronic network, such as the Internet. The bill presentment and payment remittance system allows the biller to create a bill and payment remittance information in a format specified by the biller. The biller submits the bill and associated payment remittance information by electronically transmitting~ it over the Internet to the consumer. Applicant points out that no amount of finessing by the Examiner can change the clear recitation of applicant's claimed limitations or the clear teaching of Remington. Remington plainly teaches that the biller sends the bill to the consumer. No automated navigation on the Internet to the biller takes place at the second Internet site. No person with any reasonable skill in the art could interpret Remington's teaching otherwise.

Response:

Resort may be had to MPEP section 2144.04 as well as the following case law as evidence of the level of knowledge of one of ordinary skill in support of the following contentions

***A. In re Shepard*, 138 USPQ 148 (CCPA 1963)**

"In considering disclosure of reference patent, it is pertinent to point out not only specific teachings of patent but also the reasonable inferences which one skilled in the art would logically draw therefrom."

B. *In re Bozek*, 163 USPQ 545 (CCPA 1969)

"Reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred"

C. *In re Fout*, 213 USPQ 532 (CCPA 1982), *In re Siebentritt*, 152 USPQ 618 (CCPA 1967)

"Express suggestion to substitute one equivalent technique for another need not be present to render such substitution obvious"

D. *In re Wood*, 202 USPQ 171 (CCPA 1979)

"In resolving the question of obviousness under 35 USC 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved"

As admitted by applicant Remington clearly discloses that bills are electronically transmitted over the internet to a consumer.

Per *In re Fout*, 213 USPQ 532 (CCPA 1982), *In re Siebentritt*, 152 USPQ 618 (CCPA 1967)

"Express suggestion to substitute one equivalent technique for another need not be present to render such substitution obvious"

Accordingly, one of ordinary skill in the art would understand that it is immaterial whether the biller sends the bill to the consumer or the consumer retrieves the bill from the biller. The end result remains the same, i.e. the bill made it to the consumer. Applicant's allegation that automation of the bill retrieval is novel is untenable.

Per *In re Venner*, 120 USPQ 192 (CCPA 1958), *In re Smith*, 73 USPQ 394

"If a new combination of old elements is to be patentable, the elements must cooperate in such manner as to produce a new, unobvious, and unexpected result. It must amount to an invention"

Per *In re Venner*, 120 USPQ 192 (CCPA 1958), *In re Rundell*, 9 USPQ 220

"It is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result"

Accordingly one of ordinary skill in the art would expect the manual process of gathering these bills to be automated as such is nothing more than applying a known technique (gathering bill data) to yield predictable results all of the data is presented to the consumer.

Applicant's Response

Applicant is grateful to the examiner for the very comprehensive and detailed "Response to Arguments".

Applicant has amended independent claim 13 to recite:

13. A computerized server connected to the Internet executing software providing an interactive bill-payment service, comprising:

- an Internet-connected computerized appliance providing access to Internet sites for a user;

- a first Internet site hosted by the server accessible by the computerized appliance comprising a first instance of the software providing an interactive interface enabling the user to select, view and pay itemized bills accessed from billing sources having Internet sites other than the first Internet site; and

- a second Internet site hosted by a second server operating a second instance of the software, accessible to the first Internet site, the second instance of software automatically

navigating to the billing sources, by proxy, on the Internet subscribed to by the user, logging in to the user's billing sources as if the user collecting itemized bills and bill-related data for the user, and providing the itemized bills and bill-related data to the first Internet site.

Applicant believes that claim 13, as amended, provides specific limitations which extend beyond the reasonable inferences in the art which one skilled in the art would logically draw. Applicant believes that one with skill in the art with the knowledge of Schrader and Remington's ability to receive bills from a biller or provide an interface at a vendor enabling a user to pay the vendor's bill, would not infer a server having software which automatically navigates to Internet sites for the user, logging in on behalf of the user, gathering and aggregating bills and biller information and presenting the information to the user as in the claimed interactive interface. Applicant believes that the new limitation was not known at the time of filing the present invention, therefore it is novel. Applicant believes the unique software functionality, as claimed, vastly improves the art, but that in itself is not a valid rationale that it would have been obvious to one with ordinary skill in the art.

Regarding the Examiner's reliance upon 2144.04 and case law, applicant understands if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

Applicant argues that in order to determine if the facts in the prior legal cases provided by the Examiner are sufficiently similar to those in the present application under examination, applicant requires more information regarding the facts of the cases other than merely a name and decision statement. Applicant respectfully requests the Examiner provide adequate prior art teachings and information to applicant if this line of rejection is to be pursued in the next Office Action.

Also, applicant points out that the art fails to teach or suggest a manual procedure for the automatic limitation of the invention, therefore, **In re Venner** does not apply in the

present rejection because it states that it is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. It does not say "if the automatic process could have been done manually". The art fails to teach a manual activity of navigating, logging in and gathering information on behalf of a user, as claimed. Either the user pays a bill at each vendor, or the biller provides the bill to the interface. Applicant argues that the same reasoning is provided for **In re Fout**, as the case opinion states that express suggestion to substitute one equivalent technique for another need not be present to render such substitution obvious. Applicant argues that the techniques taught in the art are not equivalent, as argued above.

From the action

Claim Rejections - 35 USC § 103

5. Claims 13 and 15-23 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent 5,903,881 to Schrader et al. (Schrader) in view of MPEP section 2144.04 for the reasons set forth in section 7 of said previous Office action.

See the discussion set forth in section 3 above.

6. Claims 13 and 15-23 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent 6,070,150 to Remington et al. (Remington) in view of MPEP section 2144.04 for the reasons set forth in section 8 of said previous Office action.

See the discussion set forth in section 4 above.

Applicant's Response

Applicant points out that the Examiner rejects the presented claims under 35 U.S.C. 103(a) as being obvious over U.S. Patent 5,903,881 to Schrader et al. (Schrader) in view of MPEP section 2144.04 for the reasons set forth in section 7 of said previous Office action. Section 7 of the previous Office Action mailed 11/13/2009 states, "Claims 13 and 15-23 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent 5,903,881 to Schrader et al. (Schrader) in view of MPEP section 2144.04 for the reasons

set forth in section 10 of the previous office action mailed 6/9/2009, which in turn refers back to section 8 of the previous office action mailed 2/11/2008. Applicant argues that the claims under examination have been amended more than once since the rejection was issued in 2008 and suggests that the rejection no longer applies to the present claims.

Applicant argues that claim 13, as amended, recites a server executing software stored in memory thereby providing a bill-pay service on a new machine. Applicant's claim 13, as amended, also recites a second Internet site hosted by a second server operating a second instance of the software, accessible to the first Internet site, the second instance of software automatically navigating to the billing sources, by proxy, on the Internet subscribed to by the user, logging in to the user's billing sources as if the user collecting itemized bills and bill-related data for the user, and providing the itemized bills and bill-related data to the first Internet site.

Applicant argues that the art of Schrader allows a user to navigate to one Internet site at Wells Fargo and view and pay a credit card bill. The credit card bill may teach itemized transactions, but these transactions are not itemized bills gathered from third Internet sites, as claimed. Schrader merely teaches that a user can log onto their account at a single biller and pay their bill. Applicant's invention improves upon this art by providing bills for payment to a user that were gathered for the user at third enterprise sites, as claimed.

Applicant argues that the Examiner's ability to provide Remington, which teaches providing an Internet site where a biller can post a bill for a user cannot read or suggest the automated navigation as claimed in applicant's invention. Therefore, applicant believes claim 13, as amended, is easily patentable over the art, MPEP 2144.04, case law, Schrader or Remington, either singly or in combination. Claims 15-23 are patentable on their own merits, or at least as depended from a patentable claim.

Summary

As all of the claims, as amended and argued above, have been shown to be patentable over the art presented by the Examiner, applicant respectfully requests reconsideration and the case be passed quickly to issue.

If any fees are due beyond fees paid with this amendment, authorization is made to deduct those fees from deposit account 50-0534. If any time extension is needed beyond any extension requested with this amendment, such extension is hereby requested.

Respectfully Submitted,
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